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Amendment "A", especially when considered in combination with the PETITION TO CORRECT ORIGINALLY NAMED INVENTORS, were patentably distinguishable from the cited art of record. Notably, the rejection of the pending claims in the May 21, 1999 Office Action involves newly cited references. It is also important to note, the amendments to the claims proffered by the present response formed an integral part of and were included in the dependent claims remaining in the application following Amendment "A" and, thus, should have been considered and examined in response to Applicants' filing of the March 2, 1999 Amendment "A". For these and other reasons, entry of the present response is respectfully requested.

As mentioned, Applicant respectfully requests reconsideration of the PETITION AND FEE TO CORRECT ORIGINALLY NAMED INVENTORS (37 CFR §1.48(a)) originally presented along with Applicants March 2, 1999 Amendment "A". In the May 21, 1999 Action, the Examiner contends Applicants PETITION filed with the March 2, 1999 Amendment "A" lacks a corroborating statement from each person being deleted as an inventor indicating the error in inventorship occurred without deceptive intent on his or her part as set forth under 37 CFR §1.48(a)(1). In a telephone conference, Examiner Watson explained the PETITION he received did not include a statement from Brian L. Launder indicating the error in inventorship occurred without deceptive intent. Attached as Exhibit "A" is a copy of a post card receipt evidencing a three (3) page signed Verified Statement of Brian L. Launder was filed with the United States Patent and Trademark Office in connection with the PETITION AND FEE TO CORRECT

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ORIGINALLY NAMED INVENTORS (37 CFR §1.48(a)).

Attached as Exhibit "B" is a copy of Brian L. Launder's three (3) page Verified Statement. Attention is directed to the penultimate sentence of Paragraph 3 of Mr. Launder's statement. Therein, Brain L. Launder sets out, at the time he originally executed the Declaration and Power of Attorney, he believed the invention disclosed in the patent application he reviewed to be attributable to himself and Mr. Charles Clendenning "without deceptive intent." Given the above, it would appear the PETITION included with Applicant's March 2, 1999 Amendment did satisfy all the requirements of 37 CFR 1.48(a)(1). Accordingly, reconsideration of Applicants' PETITION is respectfully requested.

If and when it is necessary, Applicant would be willing to submit a Terminal Disclaimer in a manner obviating any potential for a double patenting rejection of the subject invention in view of U.S. Patent No. 5,765,301 to C. Clendenning.

By the present response, a certain amendment to the specification is proffered to overcome the objection listed in Paragraph 1 of the Action. More specifically, Page 26 of the specification has been amended to pluralize the term "embodiment". This is the same amendment which was attempted in the March 2, 1999 Amendment "A" except the amendment proffered under Amendment "A" inadvertently listed the wrong location in the specification for such change to be affected. In view of the instant amendment to the specification proffered by the present response, reconsideration and removal of the objection to the specification is respectfully

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requested.

In Paragraph 2 of the Action, the drawings were objected to under 37 CFR §1.84(p)(5). The attached LETTER TO THE OFFICIAL DRAFTSPERSON furthermore requests approval of certain amendments to the drawing figures as illustrated in red on the sheets attached to the LETTER TO THE OFFICIAL DRAFTSPERSON. The proffered amendments to the drawings have been prepared with the Examiner's comments in Paragraph 2 of the Action in mind. Consideration and entry of the attached LETTER TO THE OFFICIAL DRAFTSPERSON to obviate the objections to the drawings under 37 CFR §1.84(p)(5) listed in Paragraph 2 of the Action is respectfully requested. Moreover, reconsideration and removal of the objection to the drawings is respectfully requested.

The objection to disclosure in Paragraph 3 of the Action is not understood and respectfully traversed. In a preferred form of the invention, the adapter has pairs of stabilizing lands thereon. Each pair of stabilizing lands on the adapter includes a stabilizing land on the upper outer slanted surface of the adapter and a vertically aligned stabilizing land on the lower outer surface of the adapter. As illustrated in the drawings, each pair of stabilizing lands on the adapter are spaced in a fore-and-aft relationship relative to each other. In a preferred form of the invention, the excavating tooth likewise has pairs of stabilizing lands which are disposed within the cavity of the tooth in complementary relationship to the stabilizing lands on the adapter. Applicant fails to understand or appreciate why such structure is confusing. Moreover, Applicant

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disagrees some form of punctuation is required between the term "adapter 312" and the term "tooth 324" as requested in the Action. Reconsideration and removal of the objection is respectfully requested.

A rejection of Claims 26 and 28 under 35 USC §112(2) is listed in Paragraph 4 of the Action. By the present response, amendments to Claims 26 and 28 are being proffered in a manner obviating the rejection under 35 USC §112(2). More specifically, and with the guidance of the Office Action, Claims 26 and 28 have been amended in a manner clarifying which forces are being transmitted by the structure set forth in the claims. Accordingly, reconsideration and removal of the 35 USC §112(2) is respectfully submitted.

In Paragraphs 5 and 6 of the Action, pending Claims 1 through 32 were rejected under 35 USC §102(e) under U.S. Patent No. 5,765,301 to Charles Clendenning. As mentioned in connection with Amendment "A", the PETITION TO CORRECT ORIGINALLY NAMED INVENTORS supports a finding that Mr. Charles Clendenning is the sole inventor of the invention disclosed in the present patent application.

Notably, U.S. Patent No. 5,765,301 - the reference relied in rejecting pending Claims 1 through 32 - names Charles Clendenning as the inventor thereof. Accordingly, the inventor of the invention disclosed in the present application and the inventor of the reference relied upon in rejecting the pending claims are one and the same. As clearly set forth in the Action, 35 USC §102(e) applies only when:

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent . . . (emphasis added).

Here, the invention disclosed in the subject patent application IS NOT described in a patent "by another" since Charles Clendenning is the sole inventor of both this invention as well as that disclosed in U.S. Patent No. 5,765,301. Given the above, and in view of the PETITION filed in connection with this patent application, the statutory provisions of 35 USC §102(e) DO NOT apply to the factual underpinnings of the instant application. Accordingly, reconsideration and removal of the rejection of Claims 1 through 32 under 35 USC §102(e) in view of U.S. Patent No. 5,765,301 to Charles Clendenning is respectfully requested.

By the present response, pending Claims 64 and 71 have been amended to further patentably distinguish the invention set out therein from the cited art of record. The invention defined in amended Claim 64 relates to an excavating tooth for a ground engaging implement. The tooth comprises an elongated wedge shaped member having a blind cavity opening to a rear end of the member. The cavity defined by the elongated member includes laterally spaced side surfaces with upper and lower surfaces converging toward a free end of the tooth. The tooth further includes a pair of aligned holes defining a vertical axis which passes through the cavity. Each of the tapered surfaces of the cavity has a rearwardly disposed horizontal transmitting section. Each transmitting section includes a generally flat stabilizing surface defined by a recess in the tapered surface of the blind cavity. Notably, the flat stabilizing surface of each transmitting

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section has a lateral width less than the distance between the laterally spaced surfaces or sides of the blind cavity. Moreover, each transmitting section further includes a generally vertical wall disposed, at least partially, to opposite lateral sides of the vertical axis defined by the aligned holes. The generally vertical wall of each transmitting section extends at least partially in a fore-and-aft direction between the horizontal stabilizing surface and a respective tapered surface on the elongated wedge shaped member.

The invention defined in amended Claim 71 relates to an adapter for an excavating implement. According to amended Claim 71, the adapter comprises an axially elongated member having a nose portion and a pair of outer tapered surfaces with lateral spaced sides extending between the outer tapered surfaces. Toward a rear end, the nose portion of the adapter includes a bore defining a generally vertical axis. Each tapered surface on the nose portion of the adapter has a rearwardly disposed substantially horizontal land section. The land sections on the tapered surfaces of the nose portion of the adapter each include a relatively flat generally horizontal stabilizing surface extending normal to and intersecting with the vertical axis defined by the bore in the adapter. Each relatively flat generally horizontal stabilizing surface is defined by a projection extending from a respective tapered outer surface on the nose portion of the adapter. According to amended Claim 75 the horizontal stabilizing surface has a lateral width less than the spacing between the sides of the nose portion of the adapter. Each horizontal land section on the nose portion of the adapter further includes a generally vertical wall disposed at least partially to

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opposed lateral sides of the vertical axis. According to amended Claim 75, such generally vertical walls extend at least partially in a fore-and-aft direction between the flat horizontal stabilizing surface and a respective tapered surface on the nose portion of the adapter.

In Paragraphs 7 and 8 of the Action, pending Claims 64 and 71 were rejected under 35 USC §102(b) over U.S. Patent No.4,727,663 to F. C. Hahn.

Applicant respectfully submits amended Claims 64 and 71 are patentably distinguishable from the Hahn reference either taken alone or in combination with the other cited art of record. The Hahn reference fails to disclose or factually suggest either an excavating tooth design like that presented in amended Claim 64 or an adapter as defined in amended Claim 71. Unlike the invention defined in amended Claim 64, the Hahn reference does not disclose an excavating tooth having a generally horizontal stabilizing surface whose width is less than the lateral spacing between the interior side surfaces defined by the blind cavity in the tooth. The Hahn reference does not disclose an excavating tooth having a generally horizontal stabilizing surface including a generally vertical wall. Moreover, the Hahn reference does not disclose an excavating tooth including a vertical wall extending at least partially in a fore-and-aft direction on opposed lateral sides of the vertical axis defined by the aligned holes or openings in the tooth. In contrast to the invention presented in amended Claim 64, the Hahn device merely includes a flat extending laterally across the entire width of the cavity in the tooth. Accordingly, the Hahn reference does not disclose any structure capable of transferring lateral or side loads directed against the tooth.

Nothing within the four corners of the Hahn reference suggests restructuring the cavity in the tooth to include a vertical wall extending at least partially in a fore-and-aft direction on opposed sides of the vertical axis defined by the openings in the tooth. For these and other reasons, amended Claim 64 is considered patentable over U.S. Patent No. 4,727,663 to F. C. Hahn whether taken alone or in combination with the other cited art of record.

Claims 65 through 70 depend from and further define the patentable structure set forth in amended Claim 64. Accordingly, Claims 65 through 70 are likewise considered to define over the Hahn reference whether taken alone or in combination with the other cited art of record. directed against the tooth.

Similar reasoning applies to amended Claim 71. In contrast to the structure presented in amended Claim 71, the Hahn reference fails to disclose or factually suggest an adapter including horizontal stabilizing surfaces as defined in amended Claim 71. The Hahn reference does not disclose an adapter having a generally horizontal stabilizing surface whose width is less than the lateral spacing between the interior side surfaces defined by the blind cavity in the tooth. The Hahn reference does not disclose an adapter having a generally horizontal stabilizing surface including a generally vertical wall. Moreover, the Hahn reference does not disclose an adapter having a vertical wall extending at least partially in a fore-and-aft direction on opposed lateral sides of the vertical axis defined by the aligned holes or openings in the tooth.. In contrast to the invention presented in amended Claim 71, the Hahn device merely includes a flat extending



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laterally across the entire width of the adapter. Accordingly, the Hahn reference does not disclose any structure capable of transferring lateral or side loads from a tooth mounted on the adapter to the adapter. Nothing within the four corners of the Hahn reference suggests restructuring the adapter to include a vertical wall extending at least partially in a fore-and-aft direction on opposed sides of the vertical axis defined by the bore in the adapter. For these and other reasons, amended Claim 71 is considered patentable over U.S. Patent No. 4,727,663 to F. C. Hahn whether taken alone or in combination with the other cited art of record.

Claims 72 through 78 depend from and further define the patentable invention set out in amended Claim 71. Accordingly, Claims 72 through 78 are likewise considered to define over the Radigan reference whether taken alone or in combination with the other cited art of record.

In Paragraph 9 of the Action, pending Claims 64 through 78 were rejected under 35 USC §102(b) over U.S. Patent No. 4,338,736 to M. T. Radigan.

Applicant respectfully submits amended Claims 64 and 71 are patentably distinguishable from the Radigan device either taken alone or in combination with the other cited art of record. The Radigan reference fails to disclose or factually suggest either an excavating tooth design like that presented in amended Claim 64 or an adapter as defined in amended Claim 71. Unlike the invention defined in amended Claim 64, the Radigan reference fails to disclose or factually suggest an excavating tooth having a pair of aligned holes which define a generally vertical axis. In contrast, the Radigan device involves a side pinning tooth system. The Radigan reference does

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not disclose an excavating tooth having a generally horizontal stabilizing surface whose width is less than the lateral spacing between the interior side surfaces defined by the blind cavity in the tooth. The Radigan reference does not disclose an excavating tooth having a generally horizontal stabilizing surface including a generally vertical wall. Moreover, the Radigan reference does not disclose an excavating tooth including a vertical wall extending at least partially in a fore-and-aft direction on opposed lateral sides of the vertical axis defined by the aligned holes or openings in the tooth. In contrast to the invention presented in amended Claim 64, the Radigan device merely includes a flat extending laterally across the entire width of the cavity in the tooth. Accordingly, the Radigan reference does not disclose any structure capable of transferring lateral or side loads directed against the tooth. Nothing within the four corners of the Radigan reference suggests restructuring the cavity in the tooth to include a vertical wall extending at least partially in a fore-and-aft direction on opposed sides of the vertical axis defined by the openings in the tooth. For these and other reasons, amended Claim 64 is considered patentable over U.S. Patent No. 4,338,736 to F. C. Radigan whether taken alone or in combination with the other cited art of record.

Claims 65 through 70 depend from and further define the patentable structure set forth in amended Claim 64. Accordingly, Claims 65 through 70 are likewise considered to define over the Radigan reference whether taken alone or in combination with the other cited art of record.

Similar reasoning applies to amended Claim 71. The Radigan reference fails to disclose or

factually suggest an adapter having a bore or opening defining a generally vertical axis. In contrast to the structure presented in amended Claim 74, the Radigan device utilizes a side pinning system for maintaining the tooth and adapter in operable combination relative to each other. Additionally, the Radigan reference fails to disclose or factually suggest an adapter including horizontal stabilizing surfaces as defined in amended Claim 71. The Radigan reference does not disclose an adapter having a generally horizontal stabilizing surface whose width is less than the lateral spacing between the interior side surfaces defined by the blind cavity in the tooth. The Radigan reference does not disclose an adapter having a generally horizontal stabilizing surface including a generally vertical wall. Moreover, the Radigan reference does not disclose an adapter having a vertical wall extending at least partially in a fore-and-aft direction on opposed lateral sides of the vertical axis defined by the aligned holes or openings in the tooth.. In contrast to the invention presented in amended Claim 71, the Radigan device merely includes a flat extending laterally across the entire width of the adapter. Accordingly, the Radigan reference does not disclose any structure capable of transferring lateral or side loads from a tooth mounted on the adapter to the adapter. Nothing within the four corners of the Radigan reference suggests restructuring the adapter to include a vertical wall extending at least partially in a fore-and-aft direction on opposed sides of the vertical axis defined by the bore in the adapter. For these and other reasons, amended Claim 71 is considered patentable over U.S. Patent No. 4,338,736 to F. C. Radigan whether taken alone or in combination with the other cited art of record.

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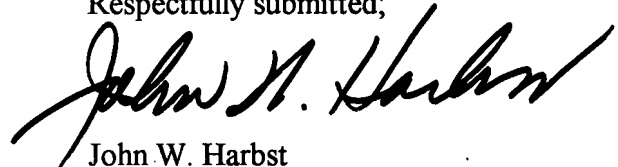
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Claims 72 through 78 depend from and further define the patentable invention set out in amended Claim 71. Accordingly, Claims 72 through 78 are likewise considered to define over the Radigan reference whether taken alone or in combination with the other cited art of record.

In view of the above, a favorable reconsideration of this patent application and an early passing of this patent application to issue is hereby courteously solicited. Should the Examiner desire to speak with Applicant's attorneys, they may be reached at the number indicated below.

Respectfully submitted;



John W. Harbst  
Attorney of Record

1180 Litchfield Lane  
Bartlett, Illinois 60103  
(630) 289-4839  
(630) 289-0269 (Fax)

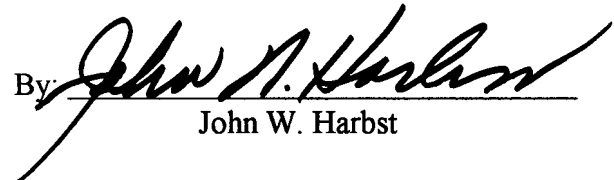
**CERTIFICATE OF MAILING**

I hereby certify this AMENDMENT AFTER FINAL REJECTION, and any papers referenced as being included therewith, is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR §1.10 in an envelope addressed to: Assistant Commissioner for Patents; **Box: AF**; Washington, D.C. 20231 on the date indicated below.

Date:

July 21, 1999

By:

  
John W. Harbst